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IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE

Serial No. : 10/629,108

Applicants : Kazuo KOYAMA et al.

Filed : July 28, 2003

For : BENZYLAMINE ANALOGUES

Art Unit : 1625

Examiner : Dr. Taofiq A. SOLOLA

Docket No. : 03338CIP/HG

Confirm. No. : 6344

Customer No. : 01933

LETTER RE: USPTO COMMUNICATION
DATED DECEMBER 31, 2008

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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S I R :

The following was stated in the USPTO COMMUNICATION dated December 31, 2008:

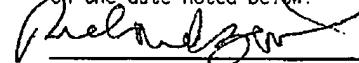
"The papers filed on 10/24/08 are timely filed but they are Office actions sent to an Examiner who issued the actions as well as IDSs previously considered and signed by the same Examiner. Informing the Examiner of his Office actions and/or previous IDSs does not constitute a proper IDS as there is nothing to inform or disclose to the Examiner which he/she didn't know. This has the potential to cause serious confusion with the Office Legal Instrument Examiners and returning an Examiner's action to him/her has the

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I hereby certify that this paper is being facsimile transmitted to the Commissioner for Patents on the date noted below.



Attorney: Richard S. Barth

Dated: January 12, 2009

In the event that this Paper is late filed, and the necessary petition for extension of time is not filed concurrently herewith, please consider this as a Petition for the requisite extension of time, and to the extent not tendered by Form PTO-2038 attached hereto, authorization to charge the extension fee, or any other fee required in connection with this Paper, to Account No. 06-1378.

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potential of wasting time and delaying
prosecution."

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The above quoted paragraph refers to copies of Office Actions in copending family member applications that were submitted in applicants' INFORMATION DISCLOSURE STATEMENT filed on October 24, 2008 (hereinafter referred to as the "October 24, 2008 IDS"). It is respectfully submitted that the October 24, 2008 IDS is a proper Information Disclosure Statement in that it presents material information with respect to patentability that is consistent with the holding in McKesson Information Solutions, Inc. v. Bridge Medical, Inc., 82 USPQ 2d 1865 (Fed. Cir. 2007). See 82 USPQ2d 1885 wherein the following is stated:

"Moreover, the MPEP at the time explained that a prosecuting attorney should not assume that [a PTO examiner] retains details of every pending file in his mind when he is reviewing a particular application. MPEP § 2001.06(b) (5th ed. rev. 3, 1986) (quoting *Armour & Co. v. Swift & Co.*, 466, F.2d 767, 779 [175 USPQ 70] (7th Cir. 1972)), and PTO regulations required all disclosures to be in writing, 37 C.F.R. §1.2; see also MPEP §2002.02 (5th ed. rev. 3, 1986)."

Respectfully submitted,

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